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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,758	10/19/2001	Daniel M. Makowiecki	IL-10939	5973

7590 04/08/2004

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EXAMINER

MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,758

Applicant(s)

MAKOWIECKI ET AL.

Examiner

Edward A. Miller

Art Unit

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See next page.</u> |

1. The reply filed on December 08, 2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): The reply does not respond to all grounds of rejection set forth in Paper No. 10, mailed June 06, 2003. See paragraphs 2 et seq. below for further detail in this matter.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

2. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Note 37 CFR 1.121(b and c), as well as 37 CFR 1.135(b), including:

"(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require." To avoid abandonment, a complete and proper reply is required. Note also MPEP 714.03, with:

"... once an inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists. Therefore, a second Office action giving another new (1 month) time period to supply the omission would not be appropriate under 37 CFR 1.135(c)."

3. In the rejection over the three Makowiecki (sole and et al.) patents, applicants' sole reply was that '799 and '748 were co-owned, in essence. The statement by attorney is adequate evidence of co-ownership. Note MPEP 706.02(l)(3). However, the statement of ownership is defective for several reasons. First, as the '911 patent is not mentioned at all, applicant has made no reply to the rejection based on this patent. The different assignee for '911 appears from the printed patent. Thus, applicant has not made any argument as to the rejection under 35 USC 103 over '911.

Art Unit: 3641

4. As the second reason, the rejection stated that the rejection included the epitome of obviousness, anticipation as to the broad claims. Applicants failed to mention in any discussion, how the claims avoided the issue of anticipation. The relief afforded by 35 USC 103(c) as to 103 rejections, does not apply to anticipations, under 35 USC 102(e).

5. Further, in view of the decision by the Board of Patent Appeals and Interferences, the benefit of parent applications SN 08/998,370 [and divisional SN 09/379,485] is denied under 35 USC 120, for failure to be "an invention disclosed in the manner provided by the first paragraph of section 112 of this title" Thus, lacking the benefit of the parent application dates, applicants' filing date of January 19, 2001 is more than one year after the patent dates of the '799 and '748 patents, whereby the 103(c) issue as to references applied with an effective date via 102(e) only is irrelevant since the references have an effective date under 35 USC 102(b). Applicants have not argued this aspect of the rejections, which was clearly stated, "However, all these references are more than one year prior to the instant application filing date," from Paper No. 10 mailed June 06, 2003, paragraph 7 on page 4 thereof. In fact, applicants failed to argue this 103 rejection at all, except as to the above noted common ownership statement.

6. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
April 5, 2004



EDWARD A. MILLER
PRIMARY EXAMINER